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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,336	12/04/2001	Martin Rex Dorricott	282476US8XCONT	6821
22850 7590 08/24/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
			NOTIFICATION DATE 08/24/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/006,336

Applicant(s)

DORRICOTT ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15, 16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16 and 18-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2007 has been entered.

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 5/29/2007. Claims **1-13, 15, 16, 18-35** are pending. Claims **1, 7, 12, 13, 25** are amended. Claims **14, 17** are canceled.

### ***Response to Arguments***

1. Applicant's arguments regarding claims **1, 7, 12, 13, 15, 16, 18, 19, and 25**, filed 5/29/2007, have been fully considered, but they are not persuasive.

Regarding claims **1, 7, 12, 13, 15, 16, 18, 19, and 25**, the applicant argues that the copies-in-use counter of Stefik et al. will be decremented each time a user stops using a work. As such, the applicant argues that Stefik et al. fails to disclose means for associating, with each metadata item relating to an electronically distributed media item, a reception indicator indicative of the number of users receiving that media item, the reception indicator incremented by one for each user who receives each media item, the reception indicator not being decremented, and the

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reception indicator not having a limit. The examiner respectfully disagrees. Note the rejections of claims 1, 7, 12, 13, 15, 16, 18, 19, and 25 under 35 USC 112, first paragraph below.

As noted by the applicant, Stefik et al. discloses a Copies-in-Use counter of the number of copies of a work that are in use. The counter is incremented when another copy is used and decremented when use is completed (col. 10, l. 50-53). Since the counter is not decremented until use of a copy is completed, the reception indicator will not be decremented if all of the copies are in use. Applicant's own specification describes the reception indicator being indicative of copies in use (indicative of users receiving the media item, monitoring the number of consumers which are listening and/or watching, etc.)(p. 1, lines 25-27 & p. 8, lines 17-19) and fails to describe what happens when use is completed. As such, the examiner maintains that Stefik et al. meets the limitation of "the reception indicator not being decremented," as currently claimed.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **1, 7, 12, 13, 15, 16, 18, 19, and 25** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 7, 12, 13, 15, 16, 18, 19, and 25**, the examiner fails to find support in Applicant's specification for the phrase "the reception indicator incremented by one for each user who receives each media item," as currently claimed. The examiner acknowledges Applicant's disclosure of a reception indicator indicative of the number of users receiving a media item (p. 1, lines 25-27) and of a reception indicator indicative of the popularity of a media item (p. 2, lines 1-2). Neither of these passages; however, provide support for incrementing a reception indicator by one for each user who receives each media item. In fact, Applicant's disclosure states that, in monitoring the number of consumers who are listening and/or watching an audio/video program, the proportion of consumers viewing/listening the program might be gathered via a set top box. A marketing centre monitors which programs are being watched by a selected sample of consumers from which marketing information and analysis is formed (p. 8, lines 17-25). As such, the examiner fails to find support in Applicant's specification for the phrase "the reception indicator incremented by one for each user who receives each media item," as currently claimed.

Further referring to claims **1, 7, 12, 13, 15, 16, 18, 19, and 25**, the examiner fails to find support in Applicant's specification for the phrase "the reception indicator not being decremented," as currently claimed. None of the aforementioned passages describing a reception indicator provide support for not decrementing the indicator. As such, the examiner fails to find support in Applicant's specification for the phrase "the reception indicator not being decremented," as currently claimed.

Still further referring to claims **1, 7, 12, 13, 15, 16, 18, 19, and 25**, the examiner fails to find support in Applicant's specification for the phrase "the reception indicator not having a

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limit,” as currently claimed. None of the aforementioned passages describing a reception indicator provide support for the reception indicator not having a limit. As such, the examiner fails to find support in Applicant’s specification for the phrase “the reception indicator not having a limit,” as currently claimed.

2. Claims 1, 7, 12, 13, 15, 16, 18, 19, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Referring to claims 1, 7, 12, 13, 15, 16, 18, 19, and 25, the examiner fails to find adequate description in Applicant’s specification to enable one skilled in the art to make a “reception indicator not having a limit,” as currently claimed. As one of ordinary skill in the art would recognize, the amount of information that can be stored in any sort of device is always limited by the device’s capacity for storage. A reception indicator not having a limit would require an infinite amount of storage. The examiner fails to find adequate description in Applicant’s specification to enable such a reception indicator.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-13, 15, 16, 18-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims 1, 12, 15, 16, 19, and 25, Stefik et al. discloses a system/method for electronic media distribution, the system comprising:

- means for generating a plurality of media items (col. 6, l. 35-40; col. 7, l. 7-8);
- a data repository (col. 7, l. 8-10) for storing a respective metadata item corresponding to multiple media items (col. 9, l. 50-67; col. 10, l. 1-23; & Figs. 5-10), each metadata item containing metadata relating to the generation of the corresponding media item (col. 10, l. 24-67);
- means for electronically distributing at least some of the media items to a plurality of end-users (col. 37, l. 52-67 & col. 38, l. 1-20);
- means for detecting reception by the end-users of the media items (copies-in-use field)(col. 10, l. 24-67); and
- means for associating, with each metadata item relating to an electronically distributed media item, a reception indicator indicative of the number of users receiving that media item, the reception indicator incremented by one for each user who receives each media item, the reception indicator not being decremented (the examiner notes that the counter is incremented for each copy being used. The counter is not decremented unless use of the copy is completed. If none of the copies are finished being used, the counter will not decrement)(copies-in-use field)(col. 10, l.

50-53) and the reception indicator not having a limit (see rejection under 35 USC 112, first paragraph above).

Referring to claims 2 and 26, Stefik et al. discloses a system according to claims 1 and 25, respectively, in which the metadata item contains at least metadata relating to the planning or commissioning of the media item (col. 10, l. 65-67 & col. 11, l. 1-6).

Referring to claims 3, 9, and 27, Stefik et al. discloses a system according to claims 1, 7, and 25, respectively, in which the media items include audio and video items (col. 6, l. 35-42).

Referring to claims 4 and 28, Stefik et al. discloses a system according to claims 1 and 25, respectively, comprising means for associating a material identifying code with each media item for electronic distribution (the examiner notes that usage rights identify that a certain fee is associated with a digital work)(col. 11, l. 44-52 & col. 18, l. 55-65).

Referring to claims 5 and 29, Stefik et al. discloses a system according to claims 4 and 28, respectively, comprising means for receiving the material identifying codes of media items received by end-users (col. 17, l. 48-67 & col. 18, l. 13-45).

Referring to claims 6 and 30, Stefik et al. discloses a system according to claims 5 and 29, respectively, in which the receiving means comprises a modem link to the end users' receiving apparatus (col. 18, l. 24-26).

Referring to claims 7, 13, and 18, Stefik et al. discloses a system/method for electronic media distribution, the system comprising:

- means for generating a plurality of media items (col. 6, l. 35-40; col. 7, l. 7-8);
- a data repository (col. 7, l. 8-10) for storing a respective metadata item corresponding to multiple media items (col. 9, l. 50-67; col. 10, l. 1-23; & Figs. 5-10), each metadata



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item containing metadata relating to copyright and/or ownership of the corresponding media item (col. 10, l. 24-67);

- means for electronically distributing at least some of the media items to a plurality of end-users (col. 37, l. 52-67 & col. 38, l. 1-20);
- means for detecting the copyright and/or ownership metadata relating to media items actually distributed to end-users (revenue-owner field)(col. 10, l. 45-67); and
- means for analyzing the media items actually distributed to end users to determine the content of the media items and generating payment information indicative of a required payment to the holder of rights defined by the copyright and/or ownership metadata based on a determination by the means for analyzing (col. 17, l. 48-67 & col. 18, l. 13-45), the means for analyzing incrementing a reception indicator by one for each user who receives each media item, the means for analyzing not decrementing the reception indicator (the examiner notes that the counter is incremented for each copy being used. The counter is not decremented unless use of the copy is completed. If none of the copies are finished being used, the counter will not decrement)(copies-in-use field)(col. 10, l. 50-53), and the means for analyzing not limiting the reception indicator (see rejection under 35 USC 112, first paragraph above).

Referring to claim 8, Stefik et al. discloses a system according to claim 7, in which the data repository is a database (col. 14, l. 7-39).

Referring to claim 10, Stefik et al. discloses a system according to claim 7, comprising means for associating a material identifying code with each generated media item, the material

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identifying code being mapped, in the data repository, to the copyright and/or ownership metadata (col. 10, l. 9, l. 50-67 & col. 10, l. 1, 8-67).

Referring to claim **11**, Stefik et al. discloses a system according to claim 10, in which the detecting means is operable to detect the material identifying code associated with media items to be distributed (col. 36, l. 29-34).

Referring to claims **20** and **31**, Stefik et al. discloses a system according to claims 1 and 25, respectively, further comprising means for logging a distribution time with a transport identifier for a transmitted media item (col. 11, l. 9-13).

Referring to claims **21** and **32**, Stefik et al. discloses the system according to claims 1 and 25, respectively, further comprising means for viewing figures generated at an analysis stage and associated with a metadata item (col. 17, l. 25-29).

Referring to claims **22** and **33**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for assigning different material identifying codes for different versions of a media item at a time the media item is distributed (col. 18, l. 6-67 & col. 19, l. 1-12).

Referring to claims **23** and **34**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for associating metadata items with each material identifying code recorded for each distributed version of a media item and saving the metadata items with each material identifying code in the data repository (col. 18, l. 54-67 & col. 19, l. 1-10).

Referring to claims **24** and **35**, Stefik et al. discloses the system according to claims 4 and 28, respectively, further comprising means for monitoring a final version of a distributed media

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item and subsequently modifying the material identifying code at distribution to include a form in which program is distributed (col. 18, l. 63-65).


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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